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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,714	10/03/2000	Arnaud Vilbert	5725.0622	8388

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/03/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,714

Applicant(s)

VILBERT, ARNAUD

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30 and 32-114 is/are pending in the application.
- 4a) Of the above claim(s) 28-30 and 32-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 27-30, 32-114 are pending. Claims 28-30, 32-114 are withdrawn from consideration, as they are directed toward non-elected subject matter.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 9/11/03 (Paper No. 27) to the rejection of claim 27 made by the Examiner under 35 USC 103, have been fully considered and deemed persuasive-in-part.

The rejection over Mougin et al. in combination with the Handbook of Cosmetic Science and Technology, both in view of Samian et al. (6,423,297) is withdrawn, as Applicant has stated and provided evidence that Samain and the instant Application were, at the time the invention was made, assigned to L'Oreal.

Since claim 27 is generic to the species elected, the rejection is maintained over Mougin et al. in combination with the Handbook of Cosmetic Science and Technology.

Election/Restrictions

Applicant's election with traverse of the Restriction Requirement in Paper No. 27 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that there would be a serious burden to examine the claims of Groups I-IV together.. This is not found persuasive. As pointed out in the previous Office Action Groups I-IV fall into different classifications and furthermore, Groups I-IV require different searches. Thus, Groups I-IV are distinct inventions. Additionally the compounds generically recited as (A) and (B) in the instant claims encompasses an incredible number of chemical compounds and combinations thereof.

Art Unit: 1617

Thus, a search of all compounds and combinations thereof, would place a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

103 Rejection Maintained

The rejection of claim 27 under 35 U.S.C. 103(a) as being unpatentable over Mouglin et al. (5,643,581) in combination with the Handbook of Cosmetic Science and Technology is MAINTAINED for the reasons set forth in the Office Action mailed 4/11/03, Paper No. 25, and those found below.

Applicant argues, "The Examiner's bald assertion is not supported by technical or legal grounds. For example, the Examiner does not explain how the mixture of two compounds would necessarily result in an aerosol having the claimed particle size. The conclusory argument based on the definition of an aerosol does not remedy this deficiency". This argument is not persuasive. The Examiner respectfully points out that the instant rejection provides a reference that teaches the state of the art of hair care formulations, wherein aerosols are taught as superior to pump sprays, and wherein such aerosols conventionally deliver hairspray compositions that have a particle size of 50 micrometers. The Examiner respectfully points out that no bald assertion has been made, as the Examiner has relied upon a reference that teaches the state of the hair care art. Additionally, it is respectfully pointed out that a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Applicant argues, "the Examiner appears to be ignoring the fact that claim 27 is a process claim comprising dispensing a hair composition using a dispenser device". This argument is not

Art Unit: 1617

persuasive. The Examiner is unclear as to why Applicant thinks the Examiner has ignored this fact, when the previous Office Action addresses this claim limitation.

Applicant argues, "the Examiner has picked parts of Mougin that appear to teach certain aspects of the claimed hair composition. The Examiner has then picked a definition out of the Handbook for an aerosol. However, the combination of these teachings from the references does not amount to a teaching or suggestion to modify Mougin's teaching of a composition into the claimed process for shampooing or holding a hairstyle". This argument is not persuasive. The Examiner respectfully points out that Mougin is directed to hair care formulations comprising film-forming polymers comprising at least one block chosen from polyurethane and polyurea blocks, wherein additional film forming polymers are taught as thickeners that are added to the composition, and wherein setting sprays that comprise compositions packaged in a sprayer that are aerosolized with air (O₂) are exemplified. The Examiner respectfully points out that this is not picking and choosing, but that this is merely re-stating what the reference teaches. Regarding the definition of an aerosol, it is respectfully pointed out that the teaching of an aerosol inherently encompasses its definition. The Examiner merely restated the definition for clarity of the previous Office Action. Thus, the definition of an aerosol is set and was not picked and chosen from a variety of definitions.

Applicant argues, "the Examiner has failed to point to the particular teaching or suggestion in either reference wherein one of ordinary skill in the art would specifically select the claimed at least one polycondensate (A), the at least one film-forming polymer (B), and the device so as to obtain, on leaving the device, droplets of said hair composition with an average diameter less than or equal to 80 μ m". This argument is not persuasive. The Examiner

Art Unit: 1617

respectfully points out, as also pointed out in the previous Office Action, that Col. 19 of Mougín exemplifies a setting spray composition packaged in a sprayer which comprises film-forming polymer (A) (pseudolatex), wherein film-forming polymer (B) is taught in the reference as an additive that increases the composition's thickness. The Examiner respectfully points out that this is a particular teaching.

Applicant argues, "While the Handbook teaches that hairsprays conventionally have an average particle size of 50 micrometers, this does not rise to the level of a specific teaching or suggestion to make particular selections with regard to components of the hair composition and the device so that particular size droplets of hair composition are formed upon leaving the device". This argument is not persuasive. Again, the Examiner respectfully points out that the instant rejection provides a reference that teaches the state of the art of hair care formulations (The Handbook of Cosmetic Science and Technology), which teaches aerosols as superior to pump sprays, wherein such aerosols conventionally deliver hairspray compositions that have a particle size of 50 micrometers, and that a change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 1617


will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1200-1600